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BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER

ROBINSON, GRETA LEE

ART UNIT PAPER NUMBER

2168

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/714,283

Applicant(s)

GARLAND ET AL.

Examiner

Greta L. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 17-23 and 31-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14, 24-26, 29, 30 and 35-38 is/are rejected.
- 7) ☒ Claim(s) 15, 16, 27 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-38 are pending in the present application. Claims 1-8, 17-23 and 31-34 are withdrawn. Claims 9 and 24 have been amended.

Drawings

2. The drawings were received on October 02, 2006. These drawings are acceptable.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 37 and 38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As present written claims 37 and 38 are directed to an abstract idea in which a concrete, useful tangible result does not occur. The claim simply presents various structures such as "query computer", "monitor computer" and "database". The claim does not recite a functional tangible result for each cited structure.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 35 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Pearson US Patent Application Publication No. 2003/0028610 A1.

Regarding claim 35, **Pearson** teaches a method comprising:

establishing a connection to a plurality of computers [note: paragraph 0027

Internet Protocol; Figures 3 and 4];

requesting a list of files shared by each of the plurality of computers [note: Figure 6];

obtaining from each of the plurality of computers the list of files shared by that computer [note: Figure 7]; and

storing the obtained plurality of lists of shared files in a database [note: Figure 7 step(190); abstract; paragraph 0046 and 0049-0053].

Regarding claim 37, Pearson teaches a query computer coupled to a network to issue a query to a plurality of peer-to-peer network [note querying host 102];

a monitor computer coupled to the network to block the download request from the query computer [note: get user's choice of file download step 128 Figure 5;

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paragraph 029 note protocol module]; and a database to store a copy of the download request [Figure 7 step 190].

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 9-12, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta et al. US Patent Application Publication No. 2002/0138471 A1 in view of Nair.

As per independent claim 9 Dutta teaches:

a computer coupled to the network at fig.4, paragraph 70;
a database coupled to the computer at fig.4, paragraph 70 (client rating database);
a query device adapted to request a list of shared files from a plurality of computers connected to the network at paragraph 59, lines 1-4;
and a transfer device adapted to transfer the a list of shared files from each computer of the plurality of computers and store the list of shared files in the database at paragraph 60, lines 1-4, also note *shared file list* 264 paragraph 0041.

Dutta does not explicitly teach transferring passively; however Dutta et al. does teach passively tracking peer-to-peer actions [note: paragraph 0066]. Nair teaches this feature [see: paragraph 9]. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to make it simple to find and exchange files (parg. 9, lines 16-17). Also because Nair teaches the peer-to-peer network provides for anonymous transfer of files.

As per claim 10 same as claim arguments above and Dutta teaches: further comprising an inventory preparation server coupled to the database at paragraph 71(client ratings database) and parg. 77, lines 11-13, rating server.

As per claim 11 same as claim arguments above and Dutta teaches:
further comprising an archiving system coupled to the database, the archiving system to store at least one copy of the plurality of lists at paragraph 71(client ratings database).

As per claim 12 same as claim arguments above and Dutta teaches:
further comprising an inventory processing server coupled to the database at paragraph 71.

As per independent claim 24 Dutta teaches:

coupling a computer to a database at fig.4, paragraph 70;

coupling the computer to the network at fig.4, paragraph 70 (client rating database); locating a plurality of computers connected to the network by IP address at paragraph 71, lines 4-5;

requesting a listing of a library of shared files from each of said plurality of computers connected to the network at paragraph 59, lines 1-4;

passively transferring the listing of the plurality of libraries of shared files from the computer to the database ... at paragraph 60, lines 1-4 and paragraph 0041.

Dutta does not explicitly teach passively however Nair does teach this limitation at parag.9. It would have been obvious to one of ordinary skill in the art at the tie of the invention to combine the cited references to make it simple to find and exchange files (parg. 9, lines 16-17).

As per claim 25 same as claim arguments above and Dutta teaches:

further comprising adding source information to each of the listings at paragraph 71. As per claim 26 same as claim arguments above and Dutta teaches:

wherein the source information comprises the geographic location of a computer where the library is stored at paragraph 71.

9. Claims 13-14 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta et al (Pub. No.: US 2002/0138471) and Nair (US 2004/0193900) in view of O'Kane (Pub. No.: US 2003/0105831).

As per claim 13-14 same as claim arguments above and Dutta teaches: further comprising an inventory preparation server coupled to the database, an inventory

processing server coupled to the inventory preparation server at fig.4. Dutta and Nair do not explicitly teach a report preparation server coupled to the inventory processing server however O'Kane teaches this limitation at paragraph 62, lines 1-6 and paragraph 63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to allow intellectual property owners a means to track royalties at paragraph 19, lines 1-4.

As per claim 29-30 same as claim arguments above and Dutta and Nair do not explicitly teach generating at least one report including data from a plurality of listings and a plurality of search requests however O'Kane teaches this limitation at paragraph 62, lines 1-6 and paragraph 63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to allow intellectual property owners a means to track royalties at paragraph 19, lines 1-4.

10. Claims 36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearson US Patent Application Publication No. 2003/0028610 A1 in view of O'Kane (Pub. No.: US 2003/0105831).

As per claims 36 and 38 Pearson do not explicitly teach:
an inventory processing computer coupled to the database to add information to the copy of the download request in the database and a report generation to prepare a report based on information in the database. O'Kane does teach this at parg. 62-63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references because it would provide a means of analysis to the end use and tracking data.

Allowable Subject Matter

11. Claims 15, 16, 27 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

12. Applicant's arguments filed October 2, 2006 have been fully considered but they are not persuasive.

In the response Applicant argued (1) Claims 37 and 38 were rejected under 35 USC 101 as being directed to non-statutory subject matter. Claims 37 and 38 are system claims and comprise several concrete elements, three computers, a database and a report preparation server. Applicant argues the claim elements recite operations that the computer are to perform and information that the database is to store; therefore the claim is not an abstract idea and produces a concrete tangible result. (2) Regarding the rejection cited under 35 USC 102(e) Applicant argues Pearson teaches a list of computers that have a file which is different from a plurality of lists of files shared by a plurality of computers. Applicant states, even if Pearson's database or registry is considered to be a "list of files", it is not a plurality of lists of files, and is not obtained by requesting lists of shared files. Also, Pearson teaches a database that contains files for which permission to share is required, not copies of blocked download requests. (3) Applicant argues the combined references do not teach passively transferring lists of

shared files and automatically storing the lists in a database. (4) The references do not teach a report preparation server.

In response to argument, (1) above the examiner respectfully maintains the rejection. Claim 37 recites non-functional descriptive material or a mere arrangement of structures. The claim does not recite what the structures are used for and the language of the claim does not actually "issue a query", block a download, or store a copy of a download. The connection between the elements with respect to a real world result is absent. Regarding argument (2), In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a *plurality* of lists of files shared) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Note claim 35 recites "requesting a list of files shared by each of the plurality of computers". Pearson teaches the first host computer is programmed to generate from the plurality of other host computers a list of other host computers where a user has selected a file is stored [see: abstract]. Also note Dutta teaches an alternative (264) list of shared files which may be imported and exported see paragraph 0041 and Figure 2C sharable file list element 264. Regarding blocking note Pearson teaches that a default rule may be programmed by the administrators to control processing of requested files see paragraph 0046. Regarding argument (3), Dutta et al. does teach passively tracking peer-to-peer actions [note: paragraph 0066]. Nair further depicts various transmission ability paragraph 0009.

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Regarding argument (4), note O'Kane teaches devices in a file sharing environment for tracking and regulating process see paragraph 0062-0063.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Beranek US Patent 6,886,013 B1

Anand et al. US Patent 6,401,093 B1

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (571)272-4118. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim T. Vo can be reached on (571)272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Greta Robinson
Primary Examiner

Greta Robinson
Primary Examiner
December 6, 2006